

### REMARKS

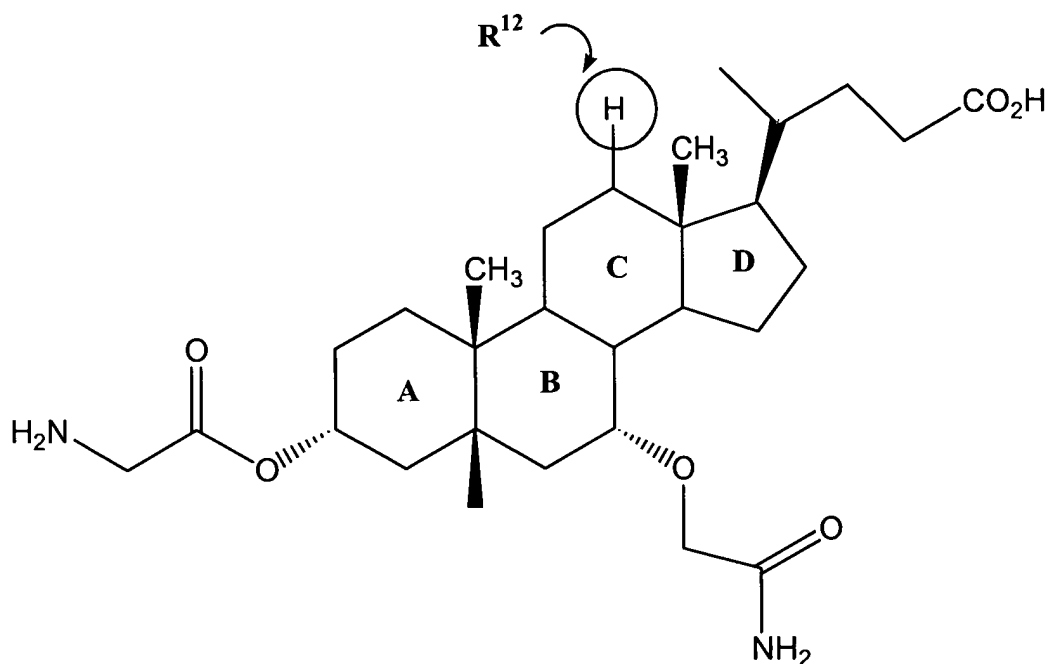
Claims 1-58 are pending. Claims 2, 4-6, 13, 15-23, 26-52, 54, and 55 are withdrawn from consideration. Claims 1 and 24 have been amended, and claim 59 has been added. Therefore claims 1, 3, 7-12, 14, 24, 25, 53, and 56-59 are pending in the application.

Applicants have amended claim 1 so as to exclude "hydrogen" from the group of permissible substituents for  $R_{12}$  in the case where all of the fused rings, A, B, C and D, are saturated. In other words, the carbon atom attached to  $R_{12}$  must be a substituted carbon atom when all of the fused rings A, B, C and D are fully saturated, i.e., there are no double bonds present in any of rings A, B, C, and D. Applicants have added claim 59, which depends from claim 1. Claim 59 differs in scope from claim 1 in that claim 59 is directed to compounds wherein  $R_{12}$  cannot be a hydrogen atom. Support for these amendments can be found throughout the specification, including at pages 23-32 (see, e.g., compounds 1, 3, 6, 7-11, 106, 108, 109, 111-114, 202, 203, 209a-209c, 324-326, 341, 343, and 356-357 in Schemes 1-16), and in claims 8, 9, 11, 12, 16, and 17-19 as originally filed. Applicants have amended claim 24 to replace the phrase "of claim 1" with the phrase "of formula (I)" and have explicitly included formula (I) as recited in claim 1 as originally filed.

Claims 1, 3, 7-12, 14, 24, 25, 53, and 56-58 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No.: 6,350,738. Applicants submit herewith a terminal disclaimer under 37 C.F.R. 3.73(b) and 1.321 (b) and respectfully request that the rejection be withdrawn.

Claim 1 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Nestler. According to the Office Action, "Nestler teaches the compound 3,7-bis[(aminoacetyl)oxy]-cholan-24-oic acid (see attached abstract). The compound taught by the reference is encompassed by the instant claims" (Office Action, part 6).

The Nestler compound is shown in the structure below. The fused rings labelled A, B, C, and D in the Nestler compound correspond to the fused rings A, B, C, and D in Applicants' formula (I). Likewise, the substituent labelled  $R_{12}$  in the Nestler compound corresponds to  $R_{12}$  in Applicants' formula (I).



Rings A, B, C, and D in the Nestler compound are all fully saturated, and the substituent corresponding to  $R^{12}$  in the Nestler compound is hydrogen. Applicants have amended claim 1 so as to exclude “hydrogen” from the group of permissible substituents for  $R^{12}$  when all of the fused rings A, B, C, and D are fully saturated. Therefore, claim 1, as amended, no longer reads on the Nestler compound, and Applicants submit that the rejection no longer applies to claim 1. Since claim 7 depends from claim 1, it is also not anticipated by Nestler. Applicants respectfully request that the rejection of claims 1 and 7 be withdrawn for the reasons set forth above.

Applicant : Paul B. Savage et al.  
Serial No. : 09/930,316  
Filed : August 15, 2001  
Page : 23 of 23

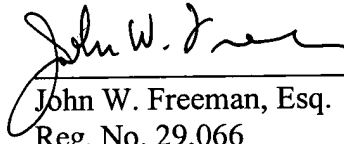
Attorney's Docket No.: 07913-006001

CONCLUSION

Applicants ask that all claims be allowed. Enclosed is a \$205 check for the Petition for Two-Month Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050, referencing Attorney Docket No.: 07913-006001.

Respectfully submitted,

Date: 8/11/03

  
\_\_\_\_\_  
John W. Freeman, Esq.  
Reg. No. 29,066

Fish & Richardson P.C.  
225 Franklin Street  
Boston, MA 02110-2804  
Telephone: (617) 542-5070  
Facsimile: (617) 542-8906